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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/008,792	11/13/2001	Geoffrey Schmit	5150-52901	4757

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EXAMINER

WACHSMAN, HAL D

ART UNIT PAPER NUMBER

2857

DATE MAILED: 05/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/008,792

Applicant(s)

SCHMIT ET AL.

Examiner

Hal D Wachsmen

Art Unit

2857

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-77 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-49 and 56-77 is/are allowed.
- 6) ☒ Claim(s) 50 and 52-55 is/are rejected.
- 7) ☒ Claim(s) 51 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                                    |                                                                             |
|----------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____                                                |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>2-18-04</u> .                                                             | 6) <input type="checkbox"/> Other: _____                                    |

1. The Applicant's petition under 37 C.F.R. 1.144 filed 2-18-04 is acknowledged however the petition is now moot because as a result of further review and reconsideration the restriction requirement is withdrawn and all of the claims (claims 1-77) have now been examined.
2. The reply filed 2-18-04 has a specification amendment that cites "Please add the following new paragraphs at page 17, line 10 (just after the above amended paragraph):" however line 10 already has the brief description for Figure 14. Appropriate correction is required.
3. As the restriction requirement has been withdrawn, all the claims in the application that have the status identifier "(Withdrawn)" require appropriate correction to their status identifier.
4. Claims 17, 18, 23, 24 and 32-49 are objected to under 37 C.F.R. 1.75(a) for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. Claim 17, lines 2-3, cite "wherein the memory medium is comprised in a computer program including a display" which can be confusing with respect to how a computer program can include a physical display. In addition, did the Applicant intend to say here that the memory medium contains a computer program ? Claim 18, line 3, cites "measurement API" which lacks antecedent basis. Claim 23 cites "said graphical diagram" which lacks clear antecedent basis. Claim 24, lines 10-11, cite "the calculated metrics" which it appears should be "the calculated one or more metrics". This same type of problem also occurs in claim 32, line 9. Claim 32, line 10, cites "the selected run-time specification" which it appears should be "the selected

candidate run-time specification". This same type of problem also occurs in claim 32, lines 11 and 13, claim 33, lines 2 and 3 and claim 35, line 3. Claim 36, lines 2 and 5, cite "the run-time specification" however the antecedent basis is "one or more candidate run-time specifications". This same type of problem also occurs in claim 39, line 2. The examiner asks the applicant to better claim the limitations cited above. While the examiner understands the intentions of the applicant he feels confusion could be drawn from the limitations cited above. Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000.

Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claims 50 and 52-55 are rejected under 35 U.S.C. 102(e) as being anticipated by Umezu et al. (6,418,391).

As per claim 50, Umezu et al. (Abstract, col. 7 lines 46-51) disclose "receiving user input specifying the measurement task". Umezu et al. (Abstract, figures 14, 24, col. 7 lines 49-67, col. 8 lines 1-38) disclose "generating a measurement task specification in response to said user input". Umezu et al. (Abstract, col. 9 lines 61-67, col. 10 lines 1-64) disclose "analyzing the measurement task specification, and generating a run-time specification for the measurement task in response to said analyzing" and "analyzing the run-time specification". Umezu et al. (Abstract, figure 9, col. 11 lines 43-67, col. 12 lines 1-41) disclose "configuring one or more measurement devices according to the run-time specification". Umezu et al. (Abstract, figures 23, 25, col. 12 lines 44-51, 60-67, col. 18 lines 1-5, 25-29, col. 28 lines 58-67, col. 29 lines 1-40, col. 35 lines 27-39, col. 36, lines 35-40, col. 44 lines 50, 51) disclose "generating a run-time based on the run-time specification, wherein said run-time is executable to perform the measurement task."

As per claim 52, Umezu et al. (figure 9, col. 11 lines 43-67, col. 12 lines 1-41) disclose the feature of this claim.

As per claim 53, Umezu et al. (col. 1 lines 18-25) disclose the feature of this claim.

As per claim 54, Umezu et al. (col. 1 lines 18-25) disclose the feature of

this claim.

As per claim 55, Umezu et al. (see at least abstract) disclose the feature of this claim.

7. Claims 1-49 and 56-77 are allowed subject to the appropriate correction of the 37 C.F.R. 1.75(a) objections noted in paragraph 4 above.

Claim 51 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

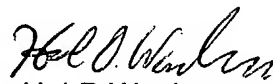
8. Applicant's arguments with respect to the claims that are rejected above are moot as rejected claims 50 and 52-55 were not previously examined on the merits. However, the Examiner does respectfully note that the Umezu et al. reference was applied prior art used in the rejection of dependent claim 30 in the previous Office action however no arguments with respect to this applied prior art were provided in the response filed 2-18-04 (see 37 C.F.R. 1.111).

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hal D Wachsman whose telephone number is 571-272-2225. The examiner can normally be reached on Monday to Friday 7:00 A.M. to 4:30 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marc Hoff can be reached on 571-272-2216. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2857

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Hal D Wachsman  
Primary Examiner  
Art Unit 2857

HW  
May 5, 2004